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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,592	03/30/2001	Katayoun Atefi	END9-2000-0117USI	1255
7590 04/03/2006			EXAMINER	
Ojanen Law Offices LTD 2665 Riverside Lane NE Rochester, MN 55906-3456			LOFTIS, JOHNNA RONEE	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/822,592

Applicant(s)

ATEFI ET AL.

Examiner

Johnna R. Loftis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a non-final office action upon examination of application number 09/822,592. Claims 1-9 and 13-20 are pending and have been examined on the merits discussed below.

Response to Arguments

2. Applicant's arguments filed 1/13/06 have been fully considered but they are not persuasive. As understood by the Examiner, a customer is given a matrix and a set of questions. The customer answers the questions and separately indicates level of maturity for each attribute. These results are compiled into a report. Finally recommendations are given for improving the service. While one of ordinary skill in the art would understand that a recommendation can be made based on an assessment of IT services, there are no guidelines to enable one of ordinary skill in the art to provide those recommendations in such a way that the process is repeatable. For example, if two assessments are performed that result in the same exact assessment results, there is nothing that prohibits different recommendations to suggest. In this case, one of ordinary skill in the art would not be able to make and or use the claimed invention since there are no guidelines suggesting proper recommendation based on assessment results. The claimed invention would not be repeatable in the way applicant had intended. Prior rejections under 35 USC 112, 1st paragraph are upheld. In addition, the recommendation process is not useful and it is not concrete since it is not repeatable. Since the newly amended claims are not directed to statutory subject matter under 35 USC 101, prior rejections under 35 USC 101 are upheld.

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3. Furthermore, prior rejection under 35 USC 112, 2nd paragraph of claim 1 regarding the indefiniteness of columns and rows of the matrix is upheld. As amended, Examiner understands that row and column are used interchangeably or that they mean the same. Prior rejections under 35 USC 112, 2nd paragraph are upheld.

4. Prior rejection under 35 USC 112, 2nd paragraph, of claim 7 is withdrawn.

5. In light of the numerous rejections under 35 USC 101 and 35 USC 112, Examiner understands applicants invention to be an application of the widely known Capability Maturity Model (CMM) developed by the Software Engineering Institute (SEI) in the late 1980's. The following rejection is based on an application of the CMM during a SEI assessment implementation at Motorola combined with the paper entitled, Capability Maturity Model for Software, Version 1.1.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-9 and 13-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, Applicant describes the use of two assessment tools that are then combined to produce

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recommendations. However, it is not understood how results from the matrix are combined with results from the questions in a way to make recommendations. In turning to the specification, the matrix appears to be a guide for one to be able to rate or rank their feelings of satisfaction concerning attributes of the service and the questions appear to be simple yes/no questions. It is not clear how the matrix indicates customer satisfaction since there is no description of how the matrix is utilized. Does the user circle the best representation of their feeling on the attribute? Does the user somehow indicate the numeric indication of maturity level somehow? Furthermore, it is not clear how results of the matrix and results of the questions are combined to provide recommendations. For example, how does one combine numeric results, if this is the case, with yes/no type answers? The brief mention of consolidating the facts and findings and determining recommendations and conclusions on page 13 of the specification is vague. There is no explanation as to how the results from the matrix and the questions are combined to make recommendations since there are no set guidelines to correlate with evaluation outcome. One of ordinary skill in the art would not be able to make and or use the claimed invention in a way that would produce a repeatable result.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-9 and 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, Applicant describes the use of two assessment tools that are then combined to produce recommendations. However, it is not understood how results from the matrix are combined with results from the questions in a way to make recommendations. In turning to the specification, the matrix appears to be a guide for one to be able to rate or rank their feelings of satisfaction concerning attributes of the service and the questions appear to be simple yes/no questions. It is not clear how the matrix indicates customer satisfaction since there is no description of how the matrix is utilized. Does the user circle the best representation of their feeling on the attribute? Does the user somehow indicate the numeric indication of maturity level somehow? Furthermore, it is not clear how results of the matrix and results of the questions are combined to provide recommendations. For example, how does one combine numeric results, if this is the case, with yes/no type answers? The brief mention of consolidating the facts and findings and determining recommendations and conclusions on page 13 of the specification is vague. There is no explanation as to how the results from the matrix and the questions are combined to make recommendations since there are no set guidelines to correlate with evaluation outcome. One of ordinary skill in the art would not be able to make and or use the claimed invention in a way that would produce a repeatable result.

Furthermore, claim 1 recites a matrix wherein each column/row corresponds to one IT service attribute and the columns/rows provide different levels of IT service maturity. It is not clearly understood what is being claimed. As claimed, each row can correspond to both an attribute and a maturity level. Furthermore it is not clear how the matrix provides an indication of customer satisfaction if all rows contain both attributes and maturity levels. In addition, in

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claim 2, it is not clear if all the rows pertain to the same attribute or if each row represents each of the attributes. Clarification to the claims is required.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-9 and 13-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For an invention to be statutory it must produce a useful, concrete and tangible result. However, in the present case, since there is no description of how the matrix provides an indication of a customer's satisfaction, and since there is no description of how one combines the results from the matrix and the questions to make recommendations, one would not be able to use the results from the matrix to combine with the results from the questions leading to recommendations for improvement. Hence, the claimed invention is not concrete and not useful since one would not know how to make or use the invention and would thereby not result in a useful outcome. One would not know how to make recommendations since there are no set guidelines to correlate with evaluation outcome. One of ordinary skill in the art would not be able to make and or use the claimed invention in a way that would produce a repeatable result.

Furthermore, in determining maturity of IT service, there is no clear description of what a "perceived IT service attribute" is and how it is compared to an "established level or IT service".

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If Applicant meant to compare the perceived level of IT service with the established level of IT service, corrections need to be made to the claims. If this assertion by the examiner is correct, there is no indication as to how the maturity of IT service determined from the comparison of the perceived level and the established level of IT service. Therefore, the determination of IT maturity is also not concrete and does not produce a useful result.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-9 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Daskalantonakis article entitled "Achieving Higher SEI Levels" in view of the paper entitled Capability Maturity Model for Software, version 1.1

As per claims 1-9 and 13-20, Daskalantonakis teaches an assessment matrix as well as a set of questions to assess processes and using the assessments to identify weak areas for immediate attention and improvement (page 1, pages 2 and 3 show the matrix, page 4 shows questions, pages 5 and 6 show compilation of results wherein assessment scores are shown for each key area during the current quarter as well as the previous quarter.) According to page 2, key areas include approach (=policies and procedures), deployment (=consistency of delivery) and results (=use of results). In addition, page 6 includes intergroup coordination (=teamwork) and defect prevention (=defect handling). Daskalantonakis also teaches the assessments

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performed at Motorola are indicative of achieving an SEI level in accordance with the capability maturity model. Inherent to the capability maturity model are the levels including initial (=ad hoc), repeatable, defined (=consistent), managed (=exceptional), and optimizing (=world class). (see page 8 of the paper entitled Capability Maturity Model for Software, version 1.1).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Software Capability Evaluation (SCE) Version 2.0 Implementation Guide

Khayat et al, US 6,327,571 – method and apparatus for hardware realization process assessment

Lehmann et al, US 5,737,727 – process management system and method

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R. Loftis whose telephone number is 571-272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JL
3/30/2006

Susanna M. Diaz
SUSANNA M. DIAZ
PRIMARY EXAMINER

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